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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT PAPER NUMBER

2854

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,292

Applicant(s)

VEIL, JURGEN

Examiner

Dan Colilla

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-12 and 16-18 are objected to because of the following informalities:

In claims 1, 9 and 16, applicant recites the step of, "dividing said substrate into copies." This phrase appears to be a literal translation from a foreign language and is not clear from the claims or the disclosure what is actually occurring in this step. For examination purposes this phrase will be interpreted to mean --supplying blank substrates for printing.--

In claim 6, lines 2-3, applicant recites, "and another ink system" which would indicate a third ink system. However, it appears that applicant does not intend to mean a third ink system. If this is the case, then applicant should recited, --the second ink system-- or --the other ink system--.

Also in claim 6, applicant recites "an ink typically used for offset printing." This is indefinite because the term "typically" does not clearly define what is or is not included in the scope of the claim.

Similarly, in claims 8 and 16, use of the term "customarily" is indefinite because it is not clear what is or what is not included in the scope of the claim

In claim 11, line 1, "said ink systems" has no antecedent basis in the claims.

In claim 16, lines 6, applicant recites, "said ink film having two different ink systems." It is not clear what applicant intends to mean by this.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 12, and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 2, applicant recites that the ink systems differ from one another with respect to “lacquer absorption capacities.” However, applicant has not disclosed any examples of inks and/or lacquers that have such characteristics. Therefore, one of ordinary skill in the art would not be able to carry out the recited method.

Similarly, in claim 12, applicant recites a binder and a binder but not disclose any what types of inks or binders and/or lacquers that have the claimed characteristics.

In claim 16, applicant recites that “degrees of gloss vary among areas of different ink systems.” Again, no specific examples of inks and/or lacquers have with these characteristics have been disclosed.

With respect to claim 17, applicant has not disclosed specific lacquer examples that have the characteristics recited in this claim.

In claim 18, applicant recites “one or more gloss-determining components” of a lacquer that can be absorbed an ink film, but applicant has not disclosed any specific examples of these gloss-determining components.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadler et al.

With respect to claim 1, Stadler et al. discloses the claimed method except that it is silent on lacquer absorption of the second ink system. Stadler et al. discloses a method of printing on a substrate including the steps of supplying a stack of substrates for printing (see Figure 1 of Stadler et al), producing a printed image with a flexo printing unit 3 (Stadler et al., col. 3, lines 61-65) that uses a first ink system, and an offset printing unit 9 (Stadler et al., col. 3, lines 61-65) that prints an image on the substrate with a second ink system. Stadler et al. further discloses a varnishing unit 5 (col. 8, lines 39-48) for applying a varnish to the substrate. In col. 9, lines 9-14, Stadler et al. discloses that the varnish may be applied to the whole substrate 19. Note that Webster's Ninth New Collegiate Dictionary defines "lacquer" as a varnish. With respect to the lacquer absorption of the second ink system, through routine experimentation, one of ordinary skill in the art would be able to select appropriate inks from known printing inks to provide for the desired absorption of the lacquer based on the desired overall finish of the printed product. Note, with respect to the phrase "areas intended for application of an adhesive," a recitation of an

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intention is not a positively recited step in the method claim and therefore is not given any patentable weight in the claims.

With respect to claim 2, Stadler et al., as mentioned above, one of ordinary skill in the art would be able to select inks with various lacquer absorption properties through routine experimentation in order to provide the desired overall finish of the product.

With respect to claim 3, Figure 1 of Stadler et al. shows that the ink printed with printing unit 3 is dried with drier 38, while the ink of printing unit 9 is not dried using a drier.

With respect to claim 4, the term "small" is a comparative term without a basis of comparison in the claims. The inks recited by Stadler et al. can be considered as having a small amount of pigment compared to other inks that have much more pigment. Additionally, it would be obvious to one of ordinary skill in the art to use inks with less pigment when printed areas of a lighter shade or tint is desired.

With respect to claim 5, Stadler et al. discloses that the varnish is clear (Stadler et al., col. 8, lines 39-40).

With respect to claim 6, Stadler et al. discloses an ink used in printing unit 3 which is a UV dried ink (Stadler et al., col. 9, lines 29-46), and the other ink system is used in an offset printing press 9 and therefore is interpreted as an ink used typically in offset printing.

With respect to claim 9, Stadler et al. discloses the recited method except that it is not known to the examiner if a binder is applied to the substrate. Stadler et al. discloses a method of printing on a substrate including the steps of printing on a substrate including the steps of supplying a stack of substrates for printing (see Figure 1 of Stadler et al), producing a printed image with a flexo printing unit 3 (Stadler et al., col. 3, lines 61-65) by application of an ink film.

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Stadler et al. further discloses printing with an offset printing unit 13. While the specifics of the ink used by this printing unit are not disclosed, it is an offset printing unit and therefore it would have been obvious to use an customary offset printing ink with the printing unit. Such a customary offset printing ink would have a binder that is customarily used with the offset printing ink. Stadler et al. further discloses a varnishing unit 5 (col. 8, lines 39-48) for applying a varnish to the substrate. In col. 9, lines 9-14, Stadler et al. discloses that the varnish may be applied to the whole substrate 19. Note that Webster's Ninth New Collegiate Dictionary defines "lacquer" as a varnish. With respect to the lacquer absorption of the second ink system, through routine experimentation, one of ordinary skill in the art would be able to select appropriate inks from known printing inks to provide for the desired absorption of the lacquer based on the desired overall finish of the printed product. Note, with respect to the phrase "areas intended for application of an adhesive," a recitation of an intention is not a positively recited step in the method claim and therefore is not given any patentable weight in the claims.

With respect to claim 11, Figure 1 of Stadler et al. shows that the ink printed with printing unit 3 is dried with drier 38, while the ink of printing unit 9 is not dried using a drier.

With respect to claim 12, Stadler et al. as mentioned above one of ordinary skill in the art would be able to select inks with various lacquer absorption properties through routine experimentation in order to provide the desired overall finish of the product.

6. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadler et al., as applied to claims 1-6, 9 and 11-12 above, and further in view of Müller et al.

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With respect to claims 7-8, Stadler et al. discloses the claimed method of printing a substrate except that it is not known to the examiner if the dryer 33 is a radiation dryer. However, Müller et al. teaches that it is known to dry a varnish finish with a UV radiator device (Müller et al., col. 2, lines 17-21). It would have been obvious to combine the teaching of Müller et al. with the method of printing disclosed by Stadler et al. for the high efficiency and quick drying time afforded by a UV radiator device.

7. Claims 9-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadler et al., as applied to claims 1-6 above, and further in view of Hartung et al.

With respect to claim 9, Stadler et al. discloses the recited method except that it is not known to the examiner if a binder is applied to the substrate. Stadler et al. discloses a method of printing on a substrate including the steps of printing on a substrate including the steps of supplying a stack of substrates for printing (see Figure 1 of Stadler et al), producing a printed image with a flexo printing unit 3 (Stadler et al., col. 3, lines 61-65) by application of an ink film. In col. 9, lines 9-14, Stadler et al. discloses that the varnish may be applied to the whole substrate 19. Hartung et al. teaches an offset printing press with two lacquering units 16 and 17. The first lacquering unit 16 can be considered as applying a binder which is a varnish. It would have been obvious to combine the teaching of Hartung et al. with the method of printing disclosed by Stadler et al. for the advantage of both spot lacquering certain areas of the substrate and full-surface refinishing of the substrate.

With respect to claim 10, as mentioned above the lacquering unit applies a lacquer as a binder (also known as a varnish).

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advantage of both spot lacquering certain areas of the substrate and full-surface refinishing of the substrate.

With respect to claim 10, as mentioned above the lacquering unit applies a lacquer as a binder (also known as a varnish).


With respect to claim 16, Stadler et al. in view of Hartung et al. teaches the claimed method as mentioned above in the prior art rejection of claim 9, except for the varying degrees of gloss. However, the selection of the correct inks for providing the desired degree of gloss would have been obvious to one of ordinary skill in the art through routine experimentation.

Similarly, with respect to claims 17-18, one of ordinary skill in the art would be able to select inks for providing the desired gloss through obvious routine experimentation.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F 8:30-5:30. Faxes regarding this application can be sent to (703) 746-4405.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

July 13, 2003


Dan Colilla
Primary Examiner
Art Unit 2854